Remarks

Reconsideration of the application is requested.

Claims 1-40 have been rejected. No claims have been amended or cancelled. Accordingly, Claims 1-40 remain pending in the application.

Applicant appreciatively acknowledges the Examiner's withdrawal of the finality of the previous Office Action and the Examiner's consideration of Applicant's arguments submitted in the Appeal Brief.

Claim Rejections – 35 U.S.C. § 102

In "Claim Rejections – 35 USC § 102," on page 2 of the above-identified Office Action, claims 1, 7-11, 15-16, 18, 21, 27-31, 35-36, and 38 have been rejected as being unpatentable over U.S. Patent No. 6,839,741 issued to Tsai (hereinafter "Tsai").

Claim 1 requires:

> "processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application; and
>
> generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of said source application, by rendering said one or more user interface displays in accordance with said one or more specifications."

Examiner cites Tsai column 3, lines 25-67, column 4 line 61 through column 5 line 8, column 5 lines 26-44, and column 6 lines 36-40 for the proposition that Tsai discloses identifying one or more user interface displays rendered when the contents of the binary file are viewed using the source application. Examiner also cites the same text for the proposition that Tsai

discloses generating, by the computing device, a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays; examiner asserts that the "specification" of claim 1 is inherent in Tsai "to enable the user browser to display the attachment file." Applicant respectfully submits that such is neither explicitly nor inherently disclosed in Tsai.

For something to be inherent in the prior art:

> "The extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In Re Robertson, 169 F.3d 743 (Fed Cir 1999) (see also MPEP 2112).

Tsai discloses a method of storing email attachments in a centrally-accessible web server so that they can be removed from incoming emails and replaced with a notification to access the attachment via the server. The attachment can be viewed either in its native format or in a "web-friendly format, such as HTML format" (column 4, lines 65-66). There is no disclosure that the web-friendly format is a self-contained representation of one or more user interface displays including specifications correspondingly specifying user interface displays, where the display is as would be viewed using the source application.

Additionally, applicant submits that such is also not inherent in the disclosure of Tsai. Creating an HTML version allows users in Tsai to view the document using their browser to decide if they want to download the original (see column 5, lines 36-44). It would not be necessary to display an identical copy of the document in order to accomplish this. In fact, it is quite possible that any such conversion would generate a document not identical to the original but which merely gives the user a "gist" of the document. For example, formatting, graphical display resolution, and other aspects of the document may be altered to ease viewing with a web browser. Thus, while it is a **possibility** that the HTML conversion of Tsai creates specifications that correspond to the displays as they would appear if opened by the source application, this mere possibility is insufficient for such to be inherent in the prior art. Therefore, applicant submits that this limitation of claim 1 is not inherent in Tsai.

Therefore, for at least the foregoing reasons, applicant submits that Tsai neither explicity nor inherently suggests each and every element of claim 1 and that claim 1 is accordingly patentable over Tsai. Thus, applicant respectfully requests that claim 1 be allowed.

Each of independent claims 7, 15, 21, 27, and 35 contain in substance the same recitations earlier discussed for claim 1. Accordingly, for at least the same reasons, claims 7, 15, 21, 27, and 35 are patentable over Tsai.

Claims 3, 8-11, 16, 18, 28-31, 36, and 38 depend from claims 1, 7, 15, 21, 27, and 35 respectively. Thus, for at least the same reasons, claims 3, 8-11, 16, 18, 28-31, 36, and 38 are patentable over Tsai.

In "Claim Rejections – 35 USC § 103," on page 7 of the above-identified final Office Action, claims 2-3, 6, 12-14, 19-20, 22-23, 26, 32-34, and 39-40 have been rejected as being unpatentable over Tsai in view of U.S. Patent No. 6,178,432 to Cook *et al.* (hereinafter "Cook") under 35 U.S.C. § 103(a).

Claims 2-3, 6, 12-14, 19-20, 22-23, 26, 32-34, and 39-40 depend from claims 1, 15, 21, 27, and 35. As noted above, claims 1, 15, 21, 27, and 35 are patentable over Tsai. Further, Cook fails to remedy the deficiency of Tsai. Cook discloses a method for creating an interactive web page with hidden elements that may be displayed when the user takes some pre-determined action. It does not disclose or suggest creating a self-contained representation of one or more user displays including one ore more specifications correspondingly specifying the one or more interface displays where the displays are as they would be if viewed on the source application. Consequently, claims 2-3, 6, 12-14, 19-20, 22-23, 26, 32-34, and 39-40 are patentable over the combination of Tsai and Cook.

Claims 4-5, 17, 24-25, and 37 are rejected under 35 USC 103(a) as being unpatentable over Tsai in view of what was well known in the art at the time of the invention. Claims 4-5, 17, 24-25, and 37 depend from claims 1, 15, 21, 35 respectively which are, as noted above,

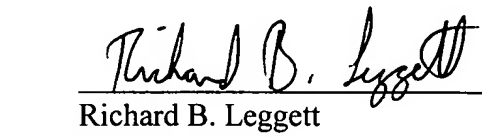
patentable over Tsai. Further, there is nothing in Tsai or what was well known in the art to suggest creating a self-contained representation of one or more user displays including one or more specifications correspondingly specifying the one or more interface displays where the displays are as they would be if viewed on the source application. Consequently, 4-5, 17, 24-25, and 37 are patentable over the combination of Tsai and what was well known in the art.

Conclusion

In view of the foregoing, reconsideration and allowance of claims 1-40 are solicited. Applicant submits that claims 1-40 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1513. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: December 1, 2006



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